

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: May 6, 2014

Opposition No. **91212441 (parent)**
Cancellation No. **92057845**

Multisorb Technologies, Inc.

v.

Clariant AG

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on opposer's motion (filed December 16, 2013) to strike the affirmative defenses in applicant's answer (filed October 22, 2013). Applicant has contested the motion as untimely. It is also noted that the parties filed a stipulated protective agreement on April 17, 2014.

Opposer's Motion to Strike

A motion to strike is timely if made before responding to the pleading that is the subject of the motion or, if a response is not allowed, within twenty-one days after being served with the pleading plus five additional days if the pleading is served by first-class mail, "Express Mail," or overnight courier. *See* Fed. R. Civ. P. 12(f) and Trademark Rule 2.119(c). Applicant served its answer via first-class mail on October 22, 2013. As such, any motion to strike matter from the answer was due no later than November 18,

2013.¹ Since opposer's motion was filed on December 16, 2013, it is untimely and opposer concedes as much in its motion. Nonetheless, the Board, in its discretion, may entertain an untimely motion to strike. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995). Considering the early stage of discovery in which the motion was filed, the number of "affirmative defenses" asserted and the importance of focusing the parties on discovery that is necessary and relevant, the Board has exercised its discretion to consider the merits of the motion.²

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP § 506.01. Motions to strike, however, are not favored and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999).

¹ Twenty-one days plus five additional days falls on November 17, 2013. However, as November 17 is a Sunday, a filing made on the following business day would be considered timely. *See* Trademark Rule 2.196.

² In this regard, applicant's request, in the alternative, for additional time to more fully address the merits of the motion is denied as to permit such leave would effectively allow applicant to file a surreply which is not considered by the Board. *See* Trademark Rule 2.127(a).

Opposer has opposed application Serial No. 85729611³ based on a claim of mere descriptiveness under Section 2(e)(1) of the Trademark Act. In response thereto, applicant has denied the salient allegations of the notice of opposition and has asserted nine putative “affirmative defenses.” These are addressed as follows:

Defense No. 1 (failure to state a claim) &
Defense No. 2 (lack of standing):

Failure to state a claim upon which relief can be granted and lack of standing are not affirmative defenses. *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828, 1830 (TTAB 1994). Nonetheless, since applicant is permitted under Fed. R. Civ. P. 12(b)(6) to assert “failure to state a claim” as a defense, opposer may test the sufficiency of said defense prior to trial by moving under Fed. R. Civ. P. 12(f) to strike it from the answer. *Order of Sons of Italy in America*, 36 USPQ2d at 1222.

In order to withstand the assertion of a failure to state a claim defense, opposer need only allege such facts as would, if proved, establish that (1) it has standing to maintain the proceeding, and (2) a valid ground exists for opposing the mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

³ For the mark OXY-GUARD in standard characters for “plastic bags and sachets for packaging; plastic packaging, namely, blister cards” in International Class 16.

On the question of standing, opposer need only demonstrate that it has a “real interest,” i.e., a personal stake, in the outcome of the proceeding and a reasonable basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A belief in likely damage can be shown by establishing a direct commercial interest. *See International Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984). Here, opposer has alleged that the parties develop, manufacture and sell similar products, are direct competitors, and that opposer has a right to use the involved mark to describe its own products. *Notice of Opposition*, ¶¶ 4, 5, and 12. As such, opposer has sufficiently pleaded its standing.

The Board further finds that opposer has sufficiently pleaded its claim of mere descriptiveness under Section 2(e)(1). *Id.*, ¶¶ 14-22. Accordingly, Defense No. 1 and Defense No. 2 are hereby **STRICKEN**.

Defense No. 3 (waiver)

Applicant has pled no facts in support thereof. Therefore, the defense is insufficient and is hereby **STRICKEN**.

Defense No. 4 (laches),
Defense No. 5 (estoppel), &
Defense No. 6 (acquiescence)

Applicant has pled no facts in support thereof. Further, laches, estoppel, and acquiescence are not available against a claim of

descriptiveness. *See Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002). Therefore, these defenses are hereby **STRICKEN**.

Defense No. 7 (unclean hands)

An allegation of unclean hands must be clear, specific, relevant and not merely conclusory in nature. *Midwest Plastic Fabricators Inc. v Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987). As applicant has pled no facts in support thereof, this defense is hereby **STRICKEN**.

Defense No. 8 (ownership of prior registration)

Applicant's claim of ownership of prior Registration No. 3859182 as a bar to this opposition proceeding, i.e., the *Morehouse* defense, *see Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), is unavailable as against a claim of descriptiveness. *See TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989). It is also unavailable where the party against whom the defense is asserted has petitioned to cancel the prior registration as opposer has done in Cancellation No. 92057845. *See Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355 (TTAB 2003). Accordingly, this defense is hereby **STRICKEN**.

Defense No. 9 (mark is inherently distinctive)

This defense is not an affirmative defense but merely an amplification of applicant's denials to the corresponding allegations in the notice of opposition. As the Board sees no prejudice to opposer in allowing the pleading of such a defense to stand, the Board declines to strike the defense at this time. *See Order of Sons of Italy in America*, 36 USPQ2d at 1223.

As the Board generally grants leave to amend pleadings that have been found insufficient, **applicant is allowed until MAY 30, 2014, in which to file and serve an amended answer** that properly sets forth any of the affirmative defenses discussed *supra*, failing which the answer of record will stand stricken as ordered herein.

Stipulated Protective Agreement

The parties' stipulated protective agreement noted earlier is **APPROVED** for use in this proceeding. The parties are referred, as appropriate, to TBMP §§ 412.03 (Duration of Protective Order), 412.04 (Filing Confidential Materials With Board), and 412.05 (Handling of Confidential Materials by the Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a

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published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Consolidation with Cancellation No. 92057845

It is noted that this opposition proceeding and Cancellation No. 92057845 involve the same or related parties⁴ and involve common questions of law or fact. The Board may consolidate pending cases that involve common questions of law or fact since consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays. *See* Fed. R. Civ. P. 42(a); *see also, Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Inasmuch as the parties to the respective proceedings are the same or related and the proceedings involve common questions of law or fact, the Board finds that consolidation of the above-referenced proceedings is appropriate. In view thereof, **Opposition No. 91212441 and Cancellation No. 92057845 are hereby CONSOLIDATED** and may be presented on the same record and briefs.⁵ The record will be maintained in **Opposition No. 91212441 as the “parent” case**. The parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each

⁴ The owner of the involved application is identified as Clariant AG whereas the owner of the involved registration in the cancellation proceeding is identified as Clariant International AG.

⁵ The parties are instructed to promptly inform the Board of any other related cases within the meaning of Fed. R. Civ. P. 42.

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paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as such in the case caption as set forth above.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. *See* 9A Wright, Miller, Kane & Marcus, Fed. Prac. & Proc. Civ. § 2382 (3d ed. 2012).

Proceedings herein are **RESUMED** and dates are **RESET** as follows:⁶

Amended Answer (if any) Due	5/30/2014
Initial Disclosures Due	6/30/2014
Expert Disclosures Due	10/28/2014
Discovery Closes	11/27/2014
Plaintiff's Pretrial Disclosures Due	1/11/2015
Plaintiff's 30-day Trial Period Ends	2/25/2015
Defendant's Pretrial Disclosures Due	3/12/2015
Defendant's 30-day Trial Period Ends	4/26/2015
Plaintiff's Rebuttal Disclosures Due	5/11/2015
Plaintiff's 15-day Rebuttal Period Ends	6/10/2015

IN EACH INSTANCE, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of taking of testimony. Trademark Rule 2.125.

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Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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⁶ Dates have been reset in accordance with the later schedule. As the opposition was suspended shortly after the filing of the motion to strike, the consolidated proceeding will follow the schedule in the opposition, as reset.